

REMARKS

These remarks are responsive to the Non-final Office Action of March 23, 2005. Claims 1, 13 and 20 have been amended to more clearly recite the claimed invention. No new matter has been added. Claims 1-20 and 23-24 are pending. Applicant respectfully requests reconsideration and allowance of the instant application.

Rejection of claims 1, 6-10, 13, and 19-20 as being unpatentable over Leman (U.S. Patent No. 6,288,706) in view of Smith (U.S. Patent No. 6,204,837)

The Office Action rejected claims 1-4, 6-10, 13-16 and 19-20 under 35 U.S.C. § 103(a) under a combination of Leman (U.S. Patent No. 6,288,706) and Smith (U.S. Patent No. 6,204,837).

Claim 1, as amended, recites a first input device for scrolling content items of a display along a first axis so as to change the direction of scrolling to movement of said content items along a second axis, the second axis being perpendicular to the first axis. Claims 13 and 20, as amended, recite a device configured for scrolling content items of a display screen relative to the display screen in one of a vertical direction and a horizontal direction so as to change the direction of scrolling to movement of said content items along the other of one of the vertical and horizontal direction.

The Office Action admits that Leman fails to teach or suggest a device for scrolling content items of a display screen relative to the display screen along perpendicular axes. See Office Action pages 2-3. Smith fails to cure the deficiencies of Leman.

Smith merely discloses assigning functions to pointing devices. A menu is displayed that allows a user to select settings for a corresponding pointing device. See Smith, col. 3, lines 19-23. By selecting a particular entry, the user may assign the corresponding function to the designated pointing device. See Smith, col. 3, lines 39-51. However, Smith fails to teach or suggest scrolling content items of a display along a first axis so as to change the direction of scrolling to movement of said content items along a second axis, the second axis being perpendicular to the first axis.

Claim 1, as amended, further recites changing the direction of scrolling to movement along a second axis when scrolling along said second axis exceeds a predetermined elapsed time, the second axis being perpendicular to said first axis. Claims 13 and 20, as amended, recite changing the direction of scrolling when scrolling along the other of one of the vertical and horizontal directions exceeds a predetermined elapsed time.

Leman and Smith, either alone or in combination, fail to teach or suggest changing direction of scrolling along a perpendicular axis when scrolling exceeds a predetermined elapsed time. The combination of Leman and Smith fails to teach or suggest scrolling or a predetermined elapsed time at all.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggest by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). As set forth above, neither Leman nor Smith, either alone or in combination teach or suggest scrolling content items of a display, changing direction of scrolling along a second axis, a predetermined elapsed time, or changing direction of scrolling when scrolling exceeds the predetermined elapsed time.

In view of the foregoing, it is respectfully submitted that the rejection of claims 1, 13, and 20 should be withdrawn.

Claims 6-10 and 19 depend from claim 1 or 13. Therefore, claims 6-10 and 19 are allowable for at least the reasons set forth above for claims 1 and 13 and further in view of the novel and non-obvious features recited therein. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988).

In addition, claim 7 recites that the first input device comprises a scroll wheel assembly. The first input device is configured for scrolling content items of a display screen relative to the display screen along perpendicular axes. The Office Action asserts that Leman discloses a thumbwheel 583 (FIG. 6B) and equates the thumbwheel 583 of Leman with a scroll wheel assembly as recited in claim 7. However, the thumbwheel 583 of Leman is merely a pointing

device and does not scroll content items of a display screen. Smith does not cure the deficiency in Leman as set forth above. The Office Action fails to address this critical deficiency in Leman and Smith.

Rejection of claims 2-5 and 14-18 as being unpatentable over Leman in view of Smith and further in view of Schnarel (U.S. Patent No. 4,720,703).

The Office Action rejected claims 2-5 and 14-18 under 35 U.S.C. § 103(a) under a combination of Leman (U.S. Patent No. 6,288,706) and Smith (U.S. Patent No. 6,204,837) and Schnarel (U.S. Patent No. 4,720,703). This rejection is respectfully traversed.

Claim 2-5 depend from claim 1 and claims 14-18 depend from claim 13. As set forth above, neither Leman nor Smith either alone or in combination teach or suggest claim 1 or claim 13. Therefore, neither Leman nor Smith, either alone or in combination, teach or suggest claims 2-5 and 14-18. Schnarel fails to cure the deficits of Leman and/or Smith.

Schnarel likewise fails to teach or suggest changing the direction of scrolling to movement along a second axis when scrolling along the second axis exceeds a predetermined elapsed time. Schnarel fails to teach or suggest a predetermined elapsed time at all. As stated above, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggest by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). None of the cited references teach or suggest all the claim limitations.

Claims 2-5 and claims 14-18 are therefore allowable for at least the reasons set forth above. In addition, Schnarel has no specific description of claim 17, e.g., the trackball device further including 1) a scrolling sensing system that 2) determines when the movable ball is rotated for vertical scrolling to 3) a threshold parameter 4) after a transition state of the horizontal scrolling 5) so as to maintain said vertical scrolling.

Furthermore, Schnarel has no specific description of claim 18, e.g., the trackball device further including 1) a scrolling sensing system that 2) determines when the movable ball is rotated for horizontal scrolling to 3) a threshold parameter 4) after a transition state of the vertical scrolling 5) so as to maintain said horizontal scrolling during said rotation.

Further, there is no motivation to combine the references. It is quite clear that "[t]he mere fact that prior art could be modified would not have made the modification obvious unless the

prior art suggested the desirability of the modification.” *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984) (reversing an obviousness rejection). In view of the foregoing, the combinations of the Leman, Smith, and Schnarel are legally improper. Hence, claims 2-5 and 14-18 are allowable. The rejection should be withdrawn.

Rejection of claims 11, 23, and 24 as being unpatentable over Leman in view of Smith and further in view of Galvin (US Patent No. 5,874,939)

The Office Action rejected claims 11, 23, and 24 under 35 U.S.C. § 103(a) under a combination of Leman, Smith, and Galvin (U.S. Patent No. 5,874,939). This rejection is respectfully traversed.

Claim 11 depends from claim 1, claim 23 depends from claim 13 and claim 24 depends from 20. As set forth above, the combination of Leman and Smith fails to teach or suggest claims 1, 13, or 20. Galvin fails to cure the deficits of Leman and/or Smith.

The Office Action asserts that Galvin discloses a keyboard responsive to voice input at col. 3, lines 55-62. Even assuming *arguendo* that Galvin provides this disclosure, Galvin still fails to teach or suggest, for example, a first input device for scrolling content items of a display along a first axis so as to change the direction of scrolling to movement of said content items along a second axis when scrolling along said second axis exceeds a predetermined elapsed time, said second axis being perpendicular to said first axis. Galvin fails to teach or suggest perpendicular axes, scrolling along an axis, changing direction of scrolling, a predetermined elapsed time, or changing direction of scrolling when scrolling along a second axis exceeds a predetermined elapsed time. It is respectfully submitted that the rejection should be withdrawn.

Rejection of claim 12 as being unpatentable over Leman in view of Smith and further in view of Bacon (US Patent No 5,473,344).

The Office Action rejected claim 12 under 35 U.S.C. § 103(a) under a combination of Leman, Smith, and Bacon. This rejection is respectfully traversed.

Claim 12 depends from claim 1. As set forth above, the combination of Leman and Smith fails to teach or suggest claim 1. Therefore, the combination of Leman and Smith fails to teach or suggest claim 12. Bacon fails to cure the deficiencies of Leman and/or Smith.

The Office Action asserts that Bacon discloses an input device configured to adjust a size

scale of a content item of a display screen. Even assuming *arguendo* that the Office Action's assertion is correct, Bacon still fails to teach or suggest, for example, a first input device for scrolling content items of a display along a first axis so as to change the direction of scrolling to movement of said content items along a second axis when scrolling along said second axis exceeds a predetermined elapsed time, said second axis being perpendicular to said first axis. Galvin fails to teach or suggest perpendicular axes, scrolling along an axis, changing direction of scrolling, a predetermined elapsed time, or changing direction of scrolling when scrolling along a second axis exceeds a predetermined elapsed time. As stated above, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggest by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) and "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The combination of Leman, Smith and Bacon fails to teach or suggest all the claim elements. It is therefore respectfully submitted that the rejection should be withdrawn.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that this application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in better form for allowance, the Examiner is respectfully urged to contact Applicant's undersigned representative at the below-listed number. If any additional fees are required or if an overpayment has been made, the Commissioner is authorized to charge or credit Deposit Account No. 19-0733.

Respectfully submitted,

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